

**REMARKS**

**Summary of the Office Action**

Claims 1, 2, 5 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,113,221 to *Weber* in view of U.S. Patent No. 6,161,924 to *Mitani et al.*

Claims 3 and 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Weber* in view of *Mitani et al.* in further view of U.S. Patent 5,736,995 to *Bohorquez et al.*

Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Weber* in view of *Mitani et al.* in further view of U.S. Patent 6,079,819 to *Deshpande et al.*

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Weber* in view of *Mitani et al.* in view of *Deshpande et al.* in further view of U.S. Patent 6,203,142 to *Imui et al.*

Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Weber* in view of *Mitani et al.* in view of *Deshpande et al.* in further view of U.S. Patent 5,988,798 to *Hirasawa et al.*

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Weber* in view of *Mitani et al.* in view of *Deshpande et al.* in view of *Imui et al.* in further view of U.S. Patent 6,139,131 to *Prasad et al.*

Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Weber* in view of *Mitani et al.* in further view of *Prasad et al.*

**Summary of the Response to the Office Action**

Applicants respectfully traverse all rejections under 35 U.S.C. § 103(a) as allegedly being unpatentable.

Accordingly, claims 1-11 are presently pending for further consideration.

**Request for Interview**

Based upon the protracted prosecution history of the present application and a willingness to discuss the specifics of Applicants' claimed invention, Applicants respectfully request a telephonic interview with the Examiner in order to advance prosecution of the present application. Accordingly, Applicants respectfully request that the Examiner contact Applicants' undersigned representative as soon as this Amendment is received and entered, and the application is made available to the Examiner in order to arrange a mutually acceptable time with which to conduct an interview.

**Information Disclosure Statement**

Applicants submitted an Information Disclosure Statement on May 23, 2006. Applicants thank the Examiner for acknowledging the Information Disclosure Statement by initialing the PTO 1449 form and returning a copy to Applicants.

**All Claims Recite Allowable Subject Matter**

Independent claim 1 stands rejected under 35 U.S.C. § 103(a) as allegedly

being unpatentable over *Weber* in view of *Mitani et al.* Independent claim 11 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Weber* in view of *Mitani et al.* in further view of *Prasad et al.* Applicants respectfully traverse the rejection for at least the following reasons.

The Office has not established a *prima facie* case of obviousness at least because *Weber*, *Mitani et al.*, and *Prasad et al.*, whether taken alone or in combination, fail to teach or suggest each and every feature of independent claims 1 and 11. Claims 1 and 11 recite, in part, that “the Ta-Si-O ternary alloy thin film resistive element is coplanar with at least two of the plurality of electrodes at the surface in contact with the ink.” *Weber*, *Mitani et al.*, and *Prasad et al.*, whether taken alone or in combination, fail to teach or suggest at least these features of claims 1 and 11.

To address these features of claims 1 and 11, the Office relies upon col. 5, lines 45-52 of *Weber* which states:

The resistor 28 is located immediately adjacent to the inlets 22. The resistor 28 acts as an ohmic heater when selectively energized by a voltage pulse applied to it. In this regard, each resistor 28 contacts at opposing sides of the resistor a conductive trace 54. The traces are deposited on the substrate 18 and are electrically connected to the printer microprocessor for conducting the voltage pulses. The conductive traces 54 appear in FIG. 5.

In other words, the conductive traces are deposited on the substrate 18, which includes a silicon base 42 and a support layer 44. Col. 4, lines 65-67. *Assuming arguendo* that the conductive traces 54 are formed on the support layer 44 of the substrate 18, any assertion that *Weber* discloses or suggests a thin film resistive element that is coplanar with at least two of the plurality of electrodes at the surface in contact with the ink is mere speculation. At best, *Weber*

is silent with respect to this feature. In addition, *Mitani et al.* discloses a thin film resistor 3 formed on an insulation layer 6 and an insulation wall 7. However, the thin film nickel conductor 5 is not coplanar with the thin film resistor 3 as shown by FIG. 2. Accordingly, *Weber* fails to teach or suggest each and every feature of claims 1 and 11. Moreover, none of *Mitani et al.*, *Prasad et al.*, *Bohorquez et al.*, *Deshpande et al.*, *Inui et al.* and *Hirasawa et al.* cure this deficiency in *Weber*. Thus, the rejections of claims 1 and 11 should be withdrawn.

As pointed out in M.P.E.P. § 2143.03, all the claimed limitations must be taught or suggested by the prior art to establish *prima facie* obviousness of a claimed invention. Because *Weber*, *Mitani et al.*, *Prasad et al.*, *Bohorquez et al.*, *Deshpande et al.*, *Inui et al.* and *Hirasawa et al.*, whether taken alone or in combination, fail to teach or suggest fail to teach or suggest each and every feature of independent claims 1 and 11, the rejections under 35 U.S.C. § 103(a) should be withdrawn. Furthermore, claims 2-10 depend from independent claim 1. Accordingly, claims 2-10 are also allowable because of the additional features they recite and the reasons stated above.

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**CONCLUSION**

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the Response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

**EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

  
**MORGAN, LEWIS & BOCKIUS LLP**

Dated: October 5, 2006

By: \_\_\_\_\_

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